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AP/3728



PATENT
Attorney Docket No. ADI-022
(257/26)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANT: Lussier
SERIAL NO.: 09/630,938 GROUP NO.: 3728
FILING DATE: December 30, 2003 EXAMINER: Marie D. Patterson
TITLE: Chassis Construction for an Article of Footwear

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Kristen G. Umlah

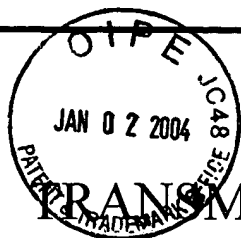
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- (1) Transmittal Form (1 pg.);
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- (3) a return receipt postcard.

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TRANSMITTAL FORM

Application Serial Number	09/630,938
Filing Date	30-Dec-03
First Named Inventor	LUSSIER
Group Art Unit	3728
Examiner Name	Marie D. Patterson
Attorney Docket No.	ADI-022
BATCH NO. (after allowance)	N/A
Patent No.	N/A
Issue Date	N/A

ENCLOSURES (check all that apply)

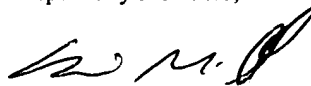
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PATENT
Attorney Docket No. ADI-022

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANT: Lussier
SERIAL NO.: 09/630,938 GROUP NO.: 3728
FILING DATE: 2-Aug-00 EXAMINER: Marie D. Patterson
TITLE: *Chassis Construction for an Article of Footwear*

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REPLY BRIEF ON APPEAL UNDER 37 C.F.R. § 1.193

This Reply Brief is submitted in response to the Primary Examiner's Answer mailed
October 30, 2003.

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The following is submitted in reply to the Primary Examiner's Answer of October 30, 2003, and addresses each argument set forth in section 11 of the Answer. The Examiner's Answer does not correlate these arguments to the lettered and numbered sections in the Appeal Brief. Instead, the Answer focuses on a subset of the references and a limited number of Appellant's arguments raised in the Appeal Brief. For clarity, Appellant has enumerated each of these points as raised in the Answer and replies as follows.

ARGUMENT

I. The claims are patentable over Crowley (U.S. Pat. No. 4,393,604).

Claims 26, 29, and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Crowley (U.S. Pat. No. 4,393,604; issued July 19, 1983).

Appellant appreciates the Examiner providing an explanation of the pertinence of the Crowley reference. Examiner's Answer, p. 3. Specifically, the Examiner refers to a "chassis" in Crowley as "formed by element 12." *Id.* The Examiner also states that "the outsole, and/or sole elements of Crowley can clearly be construed to be a chassis." Examiner's Answer, p. 9. These excerpts from the Examiner's Answer clearly show that the Examiner has mischaracterized the reference.

Crowley expressly states that the item identified by reference designator 12 is "an outsole member." Crowley, col. 2, l. 10 (emphasis added). As discussed in the Appeal Brief, Appellant's claimed chassis is distinguishable from the Crowley outsole. Further, in the footwear art, an "outsole" is the outermost sole of a shoe that is directly exposed to abrasion and wear. *See, e.g.,* The Complete Footwear Dictionary 123 (William A. Rossi ed., Krieger Publishing Co. 2nd ed. 2000). In contrast, a "chassis" is the supporting frame of a structure exclusive of the body or housing. *See, e.g.,* Merriam-Webster's Collegiate Dictionary 193 (10th ed. 2002) (emphasis added). The "body or housing" clearly corresponds to an outsole.

To support the instant rejection, the Examiner equates the Crowley outsole to Appellant's claimed chassis by first adopting a definition of "chassis" meaning "frame" and then characterizes the Crowley outsole as a "frame." Examiner's Answer, p. 9. The Examiner's

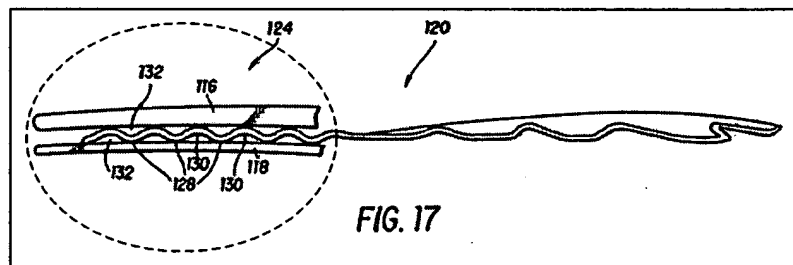
definition of chassis is incomplete because it fails to include the requirement of excluding the body or housing (i.e., outsole) as described above. Consequently, the Examiner's characterization of the Crowley outsole as a "frame" and, therefore, a chassis, is improper and inadequate to support a rejection under 35 U.S.C. § 102(b).

In view of the above, Appellant respectfully submits that Crowley fails to teach or enable at least Appellant's claimed chassis. Accordingly, a prima facie case of anticipation has not been established. *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

II. The claims are patentable over Tong et al. (U.S. Pat. No. 5,185,943).

Claims 1, 4-9, 19-21, 26-29, and 35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tong et al. (U.S. Pat. No. 5,185,943; issued Feb. 16, 1993).

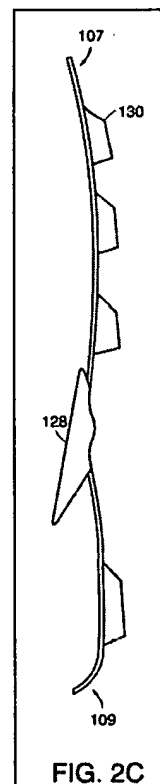
The Examiner states that the Tong et al. chassis is



considered to be "generally planar" in view of Appellant's depiction of various embodiments of the invention. Examiner's Answer, p. 9. This statement is misplaced because it is in direct opposition to the express teaching of the reference where, as stated in the Appeal Brief, the Tong et al. chassis is described having "an undulating or sinusoidal shape in cross section." Tong et al., col. 9, ll. 27-29.

The differences between the Tong et al. chassis and Appellant's claimed generally planar chassis are clearly evident, for example, when comparing their respective cross sectional views (e.g., Tong et al. Figure 17 and Appellant's Figure 2C; reproduced and annotated above and at right).

Appellant agrees with the Examiner that the limitation "generally planar" encompasses variations in the planar aspect of Appellant's chassis



depicted in certain of Appellant's figures. Examiner's Answer, p. 9. Nevertheless, Appellant respectfully disagrees with the Examiner's characterization of these variations as "great." *Id.* Appellant's claimed chassis includes only limited, simple contours to better conform to the shape of the foot. For example, the figures excerpted above show that Appellant's contours lack the inflection points and sharp changes in concavity present in the Tong et al. chassis (see the area circled in Figure 17, excerpted above). Appellant respectfully submits that at least these aspects of the Tong et al. chassis negate any characterization of that chassis as "generally planar."

With respect to claim 5, the Examiner states that indentations are shown as element 130 in Tong et al. Figure 17. Examiner's Answer, p. 10. Appellant respectfully disagrees. Element 130 is a "valley" in the Tong et al. chassis. Tong et al., col. 9, l. 38. The Tong et al. chassis has peaks 128 and valleys 130 because it has an undulating or sinusoidal shape. The term "indentation," added to claim 5 in the Amendment and Response dated Aug. 29, 2001, after consultation with the Examiner in the Interview of Aug. 2, 2001, refers to a cut, notch, or recess in a surface. *See, e.g.,* Merriam-Webster's Collegiate Dictionary 590 (10th ed. 2002) (emphasis added). The valleys 130 of the Tong et al. chassis do not disclose a cut, notch, or recess in the surface of the chassis. Rather, the valleys 130 represent a variation of the overall surface of the chassis according to its undulating or sinusoidal profile.

In view of the above, Appellant respectfully submits that Tong et al. fails to teach or enable Appellant's claimed invention, and a prima facie case of anticipation has not been established. *W.L. Gore & Assocs. v. Garlock*.

III. The claims are patentable over Trolle (U.S. Pat. No. 1,141,889).

Claims 26 and 29-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Trolle (U.S. Pat. No. 1,141,889; issued June 1, 1915) in view of Barma et al. (U.S. Pat. No. 5,546,680; issued Aug. 20, 1996).

The Examiner's Answer does not include a discussion regarding the additional reference cited in the instant rejection (Barma et al.). Consequently, Appellant relies on the arguments raised in the Appeal Brief regarding Barma et al. and will not address this reference herein.

As is the case with the Crowley reference, the Examiner mischaracterizes Trolle with respect to the distinction between the outsole disclosed in the reference and Appellant's claimed chassis. The Examiner improperly identifies the Trolle element "A" as a chassis. Examiner's Answer, p. 11. Trolle expressly states that element "A" is a shoe sole or bottom. Trolle, p. 1, ll. 34-41; p. 2, l. 8. As discussed in the Appeal Brief, the shoe sole or bottom "A" is an outsole, not a chassis. This is consistent with the definition of an outsole given above, namely, the outermost sole of a shoe that is directly exposed to abrasion and wear. Trolle teaches the use of a metal shoe sole to protect the wearer's foot from conditions that would typically lead to abrasion and wear. P. 1, ll. 52-55. Given the stiffness and rigidity resulting from its metal construction, the Trolle shoe does not require a chassis for support. The lack of any teaching in Trolle of a chassis underscores this point.

With respect to Appellant's claimed lug, Appellant respectfully disagrees with the Examiner's statement that "Trolle clearly shows a lug projection (20 and/or 31)." Examiner's Answer, p. 11. It is clear that Trolle discloses studs 20, 31 used to mount heel member "C" and sole member "D" to the shoe bottom. P. 2, l. 128 – p. 3, l. 3. Nevertheless, Appellant's claimed lug projects from a chassis that, as discussed above, Trolle fails to disclose.

In view of the above, Appellant respectfully submits that Trolle, alone or in proper combination, fails to render Appellant's claimed invention obvious.

IV. The claims are patentable over Lorenzi et al. (U.S. Pat. No. 1,684,676).

Claims 1, 4, 6-10, 19, and 26-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lorenzi et al. (U.S. Pat. No. 1,684,676; issued Feb. 7, 1925).

As discussed in the Appeal Brief, Appellant's claimed chassis is designed to provide effective power transfer. This power transfer occurs between the wearer's foot and the chassis. Specification, p. 9, ll. 24-27. The Examiner states that "cleats being attached to the chassis" in Lorenzi et al. would provide this power transfer. Examiner's Answer, p. 11. Appellant respectfully disagrees. The "cleats" in Lorenzi et al. to which the Examiner refers are calks 13. Lorenzi et al., p. 1, l. 108; Office Action, Mar. 18, 2003, p. 3. The calks 13 engage the ground –

they do not form an interface between the wearer's foot and the metal stiffening plate 4 and, therefore, cannot contribute to the power transfer therebetween.

Lorenzi et al. clearly discloses that the purpose of the metal stiffening plate 4 is to solve the problem of an upturned or curled toe portion of the sole. P. 2, ll. 65-70. The Examiner's reference to Lorenzi et al. Figure 5 and the statement in the Answer that Figure 5 illustrates the flexibility provided by the metal stiffening plate 4 wholly mischaracterizes the reference. Examiner's Answer, p. 11. To the contrary, Lorenzi et al. teaches that "[t]he stiffness given the sole of the boot by the plate will prevent the rubber sole from curling upward as shown in the dotted lines in Fig. 5." P. 2, ll. 39-42 (emphasis added). In other words, the Examiner has read into Lorenzi et al. an attribute that the reference expressly disclaims, and then uses the reference and the mischaracterized attribute as bases for the instant rejection. Appellant respectfully submits that this reasoning is flawed and insufficient support for a rejection.

The Examiner states that the Lorenzi et al. peripheral element is formed by elongated elements that are connected together at the toe and heel. Examiner's Answer, p. 12. Once again, the Examiner is reading into the reference an attribute neither taught nor suggested. Careful examination of Lorenzi et al. Figure 1 shows no seam or other feature in the periphery of the metal stiffening plate 4 that would indicate the presence of the connected elongated elements that the Examiner asserts to be present in the reference. As depicted, the periphery of the metal stiffening plate 4 is formed from a continuous structure. There is nothing in Lorenzi et al. that would suggest otherwise. Appellant respectfully submits that the Examiner's assertion that Lorenzi et al. discloses Appellant's claimed elongated elements has no basis in fact. Consequently, the Examiner's statement that "[t]here is no language in the claims that would preclude such a structure" is misplaced. *Id.*

In view of the above, Appellant respectfully submits that Lorenzi et al., alone or in proper combination, fails to render Appellant's claimed invention obvious.

V. The Examiner's other arguments.

In the Answer, the Examiner discusses a subset of the cited references and raises other issues. Appellant replied to discussion of the subset of references above, and replies to the other issues raised as follows.

A. Insufficient suggestion to combine the references; improper hindsight reconstruction.

Starting with the response to the first Office Action in 2001, Appellant has made bona fide attempts to advance the prosecution of the instant application by amending the claims to include additional limitations to clarify the claims and distinguish over the prior art. As the four subsequent Office Actions show, the Examiner has responded by adding additional references that purportedly show, alone or in proposed combinations, the elements in Appellant's claims. Although this may, on the surface, appear to be proper, a careful review of the record shows that the Examiner has mischaracterized the references and failed to appreciate that the references, alone or combined as proposed, fail to show or suggest Appellant's claimed invention.

Appellant respectfully submits that the Examiner's methodology is wholly improper, classic hindsight reconstruction. "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d (BNA) 1780, 1784 (Fed. Cir. 1994). Appellant recognizes that reconstruction is permissible, but only under certain conditions. *See, e.g., In re McLaughlin*, 170 U.S.P.Q. (BNA) 209, 212 (C.C.P.A. 1971). Reconstruction is improper when it does not rely only on the knowledge of a person of ordinary skill. *Id.* Throughout the prosecution, and in the Appeal Brief, Appellant has argued that a person of ordinary skill would not seek to modify or combine the cited references because, for example, the references have incompatible attributes and contrary objectives. The record shows that the Examiner has repeatedly (i) provided limited substantive rebuttal of Appellant's arguments, and (ii) simply sought out other references that purportedly show, alone or in a proposed combination, Appellant's claimed invention, without consideration of their incompatibility with other references or Appellant's claimed invention. As discussed in the Appeal Brief, the Examiner has relied on as many as seven different references to support a

rejection. Appellant respectfully submits that the number and disparate teachings of the references, along with a dearth of support for the proposed combinations, are clear indicators of impermissible hindsight reconstruction.

Stated differently, the Examiner's reconstruction is flawed, because it does not rely only on the knowledge of a person of ordinary skill, since a person of ordinary skill would not seek to combine the cited references in the proposed manner, for the reasons that Appellant cites. Instead, the knowledge required to arrive at the claimed invention flows directly and solely from Appellant's disclosure, meaning that the Examiner's reasoning, as set forth in the record, cannot support the stated rejections under 35 U.S.C. § 103(a).

B. The references in the proposed combination do not address the problem Appellant's invention addresses.

As discussed in the Appeal Brief, an invention is nonobvious if the elements in the reference deal with problems different than those addressed by the claimed invention. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 U.S.P.Q. (BNA) 481, 485 (Fed. Cir. 1984). The record shows that, when proposing certain combination of references, the Examiner fails to appreciate that the issue is not whether the cited references address the same problem. The proper inquiry is whether the cited references address the same problem that Appellant's claimed invention addresses.

The Examiner highlights a portion of the *Lindemann* decision to support the position that *Lindemann* is applicable only when a cited reference discloses an "entirely different device, composed of parts distinct from those of the claimed invention, and operating in a different way to process different material differently." Examiner's Answer, pp. 12-13 (quoting *Lindemann*, 221 U.S.P.Q. (BNA) at 486). As discussed in the Appeal Brief, this portion of *Lindemann* is irrelevant to rejections under 35 U.S.C. § 103. Further, the Examiner's statement that the references are "clearly directed to shoe sole parts which operate to protect and support the foot..." (Examiner's Answer, p. 13) is an overly broad definition of the problem addressed by Appellant's invention and is insufficient to establish a basis for an obviousness rejection. *Lindemann*, 221 U.S.P.Q. (BNA) at 487.

C. Appellant's alleged "piecemeal analysis of the references."

The Examiner asserts that Appellant has argued nonobviousness by engaging in a "piecemeal analysis of the references." Examiner's Answer, p. 12. Applicant respectfully disagrees. As reflected in the Appeal Brief, Appellant has analyzed exhaustively the many references used as grounds for rejection, and addressed the combinations of references that the Examiner proposed. Appellant analyzed references individually when the Examiner has not provided any indication of pertinence of the references. Section IX of the Appeal Brief contains these analyses.

D. Failure to state what would have been obvious.

The Examiner states that the rejections detailed in paragraphs 8, 9, and 10 of the last Office Action (dated Mar. 18, 2003) are "explicitly clear." Examiner's Answer, p. 12. The Examiner misapprehends Appellant's arguments corresponding to these paragraphs, and paragraph 7 of the last Office Action, as detailed in Sections V, VI, VII, and VIII of the Appeal Brief. In these Sections, Appellant argues that the Examiner failed to reject claims based on what would have been obvious to one of ordinary skill in the art at the time the invention was made. In other words, the Examiner's omission of this underlined language in the rejection of the claims calls into question whether the Examiner applied the proper standard of obviousness. The Examiner's Answer provides no clarification of this issue.

CONCLUSION

In view of the discussion above, Appellant respectfully submits that claims 1, 4-23, 26-31, and 35-39 are patentable in view of the cited references. Appellant urges the Board of Patent Appeals and Interferences to reverse the Examiner's rejections of these claims.

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